

**REMARKS**

Applicants acknowledge receipt of the Examiner's Office Action dated January 22, 2008.

**Rejection of Claims Under 35 U.S.C. § 112**

Claims 28-41 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors(s), at the time the application was filed, had possession of the claimed invention. Claims 28-41 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 21-41 were rejected as violating the written description requirement of 35 U.S.C. § 112, first paragraph. The Office Action does not argue the claims are not commensurate in scope with the Detailed Description. Rather, the Office Action notes that page 26, line 8 to page 27 line 10 most closely relates to the invention now claimed. The Office Action states page 26, lines 15-24 most closely represent the now claimed invention in that it informs the reader that for non-contiguous cases, it is "possible that memory controller 222 can pack two or more data elements into a larger block which would use memory bus 224 more efficiently." The Office Action takes issue with the use of the term "possible" within this cited section. As an aside, Applicants note that the Specification uses "possible" in the optional sense of the term. In other words, the Specification makes clear that this claim feature is optional if data elements are stored in

non-contiguous memory locations. Notwithstanding, the office action argues page 26, lines 15-24 informs the reader that it is possible to perform that which is now claimed, but provides no information to a reader detailing what invention Applicants were in possession of at the time of filing which could perform this operation of packing two or more data elements into a large block. To emphasize the nature of the written description rejection, the Office Action asserts that what is missing from the Specification is any disclosure detailing “how” the invention takes two separated values and retrieves them as a single transfer.

Again, the Office Action does not argue the currently pending claims are not commensurate in scope with the Detailed Description. Rather, the Office Action seems to indicate the claims are commensurate in scope with the Detailed Description. Applicants assert that since the claims are commensurate in scope with the Detailed Description, the claims satisfy the written description requirement regardless of whether the Specification discloses detail of how the invention as claimed and operates. In support, Applicants point to the “Written Description Training Materials,” Revision 1, March 25, 2008, published by the United States Patent and Trademark Office which can be found at [www.uspto.gov/web/menu/written.pdf](http://www.uspto.gov/web/menu/written.pdf). Appendix B and Appendix C of this document show decision trees for determining whether claims satisfy the written description requirement. As shown in Appendix C and Appendix, the written description requirement is satisfied if the claim is commensurate in scope with the Detailed Description. Noticeably missing from these decision tree is any analysis of whether the Detailed Description provides detailed disclosure of “how” the claimed invention operates. As such, Applicants assert that all pending claims are in compliant with the Written Description requirement of 35 U.S.C. § 112, first paragraph.

The Office Action also rejects the claims as violating the enablement requirements of 35 U.S.C. § 112, first paragraph. In rejecting the claims for lack of enablement, the Office Action again makes note that while the Specification details that it is possible to perform a transfer of non-contiguous memory locations via a single combined bus transfer, the Specification provides zero details as to how to perform this operation. While 35 U.S.C. § 112, first paragraph requires a disclosure that enables one of ordinary skill in the art to make and use the invention without undue experimentation, compliance with 35 U.S.C. § 112, first paragraph, does not require an indeed preferably omits what is well known in the art, and the fact that an experimentation may be complex does not necessary make it undue.

The Office Action makes an analogy in rejecting the claims as lacking an enablement. Specifically, the Office Action states that “the situation provided by Applicants specification is exactly the same as knowing from the theories of nuclear physics that it is possible to split a uranium atom and that such fissure will release energy versus knowing how to build a successful nuclear reactor to split uranium atoms and extract the released energy in a useful form” and “simply knowing that it is possible to do something does not, in and of itself, detailed to one of skill how it is that are to do that something.” Applicant believe it is improper to draw an analogy between the technology of “splitting atoms” and the claimed invention of transferring data elements that are stored in non-contiguous locations in memory. Specifically, splitting uranium atoms is a feat that is significantly more technologically complex than the act of transferring data elements between memory and a processor.

Notwithstanding, Applicants assert that the Office Action fails to establish a *prima facie* basis for rejecting the claims as violating the enablement requirement of

35 U.S.C. § 112. To comply with 35 U.S.C. § 112, first paragraph, it is not necessary to “enable one of ordinary skill in the art to make and use a perfected, commercially viable embodiment absent and claim limitation to that effect.” *CFMT, Inc. v. Yieldup International Corp.*, 349 F.3d 1333 (Fed. Cir. 2003). There are many factors to be considered in determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue. The factors include but are not limitation to: (a) the breadth of claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art... *In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988). It is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. The Examiner’s analysis must consider all the evidence related to each of these factors, and any conclusion of non-enablement must be based on the evidence as a whole. 858 F.2d. at 737, 740. The Office Action concludes that the claims violate an enablement requirement without providing an analysis of few if any of the undo experimentation factors set forth in MPEP 2164.01(a). As such, Applicants assert that the Office Action has failed to provide *prima facie* basis for rejecting the claims as being in violation of the enablement requirement.

CONCLUSION

In view of the amendments and remarks set forth herein, the application and the claims therein are believed to be in condition for allowance without any further examination and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the Examiner is invited to telephone the undersigned.

If any extensions of time under 37 C.F.R. § 1.136(a) are required in order for this submission to be considered timely, Applicant hereby petitions for such extensions. Applicant also hereby authorizes that any fees due for such extensions or any other fee associated with this submission, as specified in 37 C.F.R. § 1.16 or § 1.17, be charged to Deposit Account 502306.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Eric A. Stephenson', with a stylized, flowing script.

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